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FILED
JUL 21 1941
CHARLES ELMORE CROPLEY
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941.

No. 90.

JOGGER MANUFACTURING CORPORATION,
Petitioner-Plaintiff,

vs.

WENDELL H. ROQUEMORE, DOING BUSINESS AS MULTIGRAPH SALES AGENCY,
Respondent-Defendant.

REPLY OF RESPONDENT TO PETITION FOR WRIT OF CERTIORARI.

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Boulevard Press, Law Printers, 343 S. Dearborn St., Chicago

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Statement.

Petitioner's summary statement of the matter involved is inaccurate and insufficient in several respects. In the interest of brevity these are considered in our discussion of the reasons advanced by petitioner for the granting of the writ.

While petitioner invokes the jurisdiction of this Court under Section 240(a) of the Judicial Code as

amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347), the petition fails to present any recognized ground for the exercise of the jurisdiction of this Court under the provisions of that section. The action is one for infringement of letters patent and no conflict of decisions within the rule of *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, exists.

The petition presents four questions and advances five reasons for granting the writ. None of the questions thus presented is of such character as to require determination by this Court, and the stated reasons for granting the writ are wholly inadequate under established precedents. We shall discuss the points advanced in the argument of petitioner's supporting brief in the order in which they are presented.

ARGUMENT.

Point I.

The Court of Appeals Did Not Refuse to Enforce a License Restriction. Instead It Held that the License Was Not Restricted, as Petitioner Asserted.

The first question that petitioner propounds is whether the limitation in the license grant to identified jogger models of particular size was not a proper and enforceable restriction. This question has no basis in the record in this case. It assumes a limitation in the license grant which the Circuit Court of Appeals has held not to be present. Whether this question would be answered in the affirmative or negative is unimportant in this case, because it at no time became an issue either in the pleadings or in the presentation to either the District Court or the Circuit Court of Appeals. The decision in this case did not and does not depend

on any such issue since the Circuit Court of Appeals very properly decided that the license which was granted to the manufacturer under the license agreement was not limited to identified jogger models of a particular size. The Circuit Court of Appeals said:

> "In other words, M Company was not restricted to its so-called models 66 and 86, but, as and when the trade demanded different sizes, it could and would produce such Multigraphs, and it was licensed by plaintiff to make, use and sell models to be attached to such Multigraphs in the office equipment field" (R. 445).

Since this question here presented by petitioner was not for decision, nor was it decided by the lower courts, there is nothing for this Court to review.

In sustaining the defense of license, the Circuit Court of Appeals merely interpreted the terms of a written contract according to the intention of the parties as evidenced by the terms of the document itself so as to embrace the accused device. In so doing, it merely held that it was the intention of the parties as evidenced by the terms of the contract that the license grant was not restricted or limited as petitioner contended, but was broad enough to include devices such as that charged to be an infringement of the patents in suit. Obviously, contrary to petitioner's assertion, that determination involved no "important question of general public interest and concern never decided by this Court" and created no "precedent which throws doubt and uncertainty upon the scope of all license agreements restricted on their face to specified models or sizes of the patented device."

Petitioner's argument on this point is devoted mainly to a plea for the construction of the license con-

tract as it contended before the Circuit Court of Appeals. We do not understand that such argument is now in order.

Point II.

The Action of the Circuit Court of Appeals in Sustaining the Defense of License and Refusing to Accept the Interpretation of the Document for Which Petitioner Contends Involves No Departure from the Accepted Course of Judicial Proceedings Calling for the Exercise of the Supervisory Power of this Court.

The second question that petitioner propounds is whether it must go remediless when the decision by the Circuit Court of Appeals is predicated upon numerous mistakes of fact. Petitioner challenged the Circuit Court of Appeals' opinion on this ground in its petition for rehearing (R. 451). Respondent filed an answering brief to this petition and pointed out the testimony in the record which supported the findings of the Court which were challenged by the petitioner as being unsupported by the record (R. 477).

As we have stated the Court of Appeals interpreted the license contract according to the intention of the parties as evidenced by the terms of the document itself. It pointed to plaintiff's own conduct as supporting its view (R. 446). There is absolutely no basis for the claim that the Circuit Court of Appeals' decision is not supported by the testimony in the record.

That this question is not recognized as a sufficient ground for granting the writ is evidenced by the case of *General Talking Pictures Corporation* v. *Western Electric Co.*, 304 U. S. 175, 82 L. Ed. 1272, wherein this court said (p. 178):

"Whether respondents acquiesced in the infringement and are estopped depends upon the facts. Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. *Southern Power Co.* v. *North Carolina Public Service Co.*, 263 U. S. 508, *United States* v. *Johnston*, 268 U. S. 220, 227."

Point III.

Petitioner's Third Question Is Not Only Predicated Upon a False Assumption But Involves No Substantial Reason for Granting a Writ.

The third question that petitioner propounds is in substance whether or not there was infringement of certain patent claims. Petitioner contends that the Circuit Court of Appeals failed to consider specified claims of the second patent in suit and thereby departed from the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon*, 294 U. S. 477, 487.

The opinion clearly discloses that the Court went to unusual pains to show its reasons for non-infringement. Only one claim of the first patent was asserted. The Court discussed this claim quite extensively (R. 446). All five claims of the second patent were asserted. The Court took one claim as representative, discussed it in some detail (R. 447), and added (R. 448):

"Without going into the details of each claim we content ourselves with saying that plaintiff's patent is extremely narrow and its infringement is not shown."

Petitioner possibly confuses *consideration* with *discussion*. The Circuit Court of Appeals was clearly not

obliged to discuss each and every claim separately, as petitioner contends. The decisions of this Court show very clearly the fallacy of this contention.

In *Bassick* v. *Hollingshead,* 298 U. S. 415, ten claims were asserted, and but two discussed. In *Mantle Lamp* v. *Aluminum Co.,* 301 U. S. 544, ten claims were involved and but one claim discussed. In *Honolulu Oil Corp.* v. *Halliburton,* 306 U. S. 550, twelve claims were involved and but two discussed.

Moreover, this Court has repeatedly refused to grant a writ of certiorari on the question of whether or not there has been patent infringement in the absence of diversity of opinion between circuit courts of appeals.

In *Keller* v. *Adams-Campbell Co.,* 264 U. S. 314, 68 L. Ed. 705, the Court said (p. 319):

> "These passages . . . show that what the courts really held was that the defendants were manufacturing a different invention from that of the plaintiffs, and so could not and did not infringe. Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

In *Layne & Bowler Corporation* v. *Western Well Works,* 261 U. S. 387, 67 L. Ed. 712, the Court said (pp. 388-393):

> "This is an ordinary patent case. There was no reason for granting the application for a writ of certiorari except upon the ground that the Circuit Courts of Appeals for the Fifth and Ninth Circuits had differed in respect to the validity and scope of the patent, and that uniformity required a decision from this Court."
>
> ". . . it is very important that we be consistent

in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal."

In the very case on which petitioner relies, *General Talking Pictures Corp.* v. *Western Electric Co.,* 304 U. S. 175, this Court said (p. 178):

"Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals."

Point IV.

Petitioner's Claim that the Decision of the Court of Appeals Is in Conflict With Its Own Prior Decisions and With a Decision of this Court Is Based on a False Premise.

Petitioner's complaint is that certain claims of the patents were found not to be infringed because certain elements of these claims were not found as separate pieces in the devices sold by respondent and that this finding is in conflict with the Sutherland Paper case decided by the same Court a day before.

This ground of criticism is based on a false premise because the Court made no finding that these elements were not found "as separate pieces." The Court did find that certain elements of the claims were *entirely lacking* in respondent's structures. This decision followed many decisions of this Court such as *Dunbar* v. *Myers,* 94 U. S. 187, where the Court said (p. 202):

"it is settled law, that, where the respondent in

> constructing his machine omits one of the ingredients of the complainant's combination, he does not infringe the complainant's patent. *Gould* v. *Rees*, 15 Wall. 194; *Prouty* v. *Ruggles*, 16 Pet. 341; *Vance* v. *Campbell*, 1 Black, 427; *Gill* v. *Wells*, 22 Wall. 28."

In the *Sutherland Paper* case an entirely different question was involved. It is of course elementary that what a Court decides in one case on one set of facts can never be the basis for a review of another decision by that Court involving an entirely different set of facts.

The *Sutherland* case (118 F. (2d) 862) involved a claim calling for a piece of paper which was so folded as to provide a false bottom. The defendant, instead of using one piece of paper, glued two pieces together to make the false bottom, and the court held this did not avoid infringement. The other cases cited by petitioner are to like effect.

In the present case the only claim asserted of the first patent called for a combination of several specific elements, two of which were [4] brackets on the frame, and [5] longitudinal plates supported by the brackets, each having turned-down apertured ends. The Court found (R. 446):

> "Defendant's structures did not have a bracket attached to the frame nor was its frame attached to the bracket. It did not have downward turned apertured ends."

It is clear there was no holding by the court as stated in petitioner's brief (p. 21) "that infringement was avoided because the brackets and longitudinal plates were not found in the accused structure as separable pieces."

In discussing this patent, the Court said (R. 446):

> "It is fairly inferable from the prior art that plaintiff was required to narrow its claim and limit it to the disclosed and described invention which included elements 4 and 5."

In the second patent three of the claims call for a shroud mounted in a certain manner and a *direct* connection between certain parts. The Court found and the petitioner admits that respondent's device uses a cam instead of a shroud and the cam is not mounted in the manner called for in the claims. Hence there could be no infringement. It is also clear from the Court's Opinion and admitted by petitioner that the direct connection called for in the claims is not present in respondent's structure. The claims being limited to a direct connection, infringement is also avoided by using another kind of connection.

The Court then added (p. 448):

> "Without going into the details of each claim we content ourselves with saying that plaintiff's patent is extremely narrow and its infringement is not shown. Plaintiff's counsel has rather adroitly interchanged the functions and the elements of the accused device, thereby creating some confusion as to their equivalency. Functions may well be investigated and examined to ascertain the range of mechanical equivalents. But there is no basis for asserting infringement because of similarity of functions. There must be similarity of elements which perform the desired functions before infringement is shown. We find there was no infringement of the second patent."

It is clear that the Court applied the rule referred to on pp. 7, 8, *supra*, that in order to find infringement each element called for in the claims must be present in the defendant's structure and that where there are specific limitations in the claims which are not utilized by the defendant there can be no infringement.

We believe the limitations in the claims are clearly required by the prior art but whether or not the limitations are necessary is of no moment because the limitations are in the claims and cannot now be ignored.

This rule is especially applicable where, as here, the art is crowded and the claims of the patents are very narrow and consist of a large number of specific elements. An early and unchallenged decision in this court on this point is the case of *Keystone* v. *Phoenix,* 95 U. S. 274, where the court said (pp. 278-9):

> "Here, again, the patentees clearly confine themselves to 'wide and tnin' bars. They claim the use in truss bridges of such bars when the ends are upset and widened in the manner described. It is plain, therefore, that the defendant company, which does not make said bars at all, but round or cylindrical bars, does not infringe this claim of the patent. When a claim is so explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. . . . But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. *Merrill* v. *Yeomans,* 94 U. S. 568. He can claim nothing beyond it. But the defendant may at all times, under proper pleadings, resort to prior use and the general his-

> tory of the art to assail the validity of a patent or to restrain its construction. The door is then opened to the plaintiff to resort to the same kind of evidence in rebuttal; but he can never go beyond his claim. As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."

Petitioner insists that there is an inconsistency in the Court of Appeals decision because on the one hand it holds the license covers all joggers for machines made by respondent's manufacturer and on the other holds that the joggers sold by respondent do not come within the claims of the patents included in the license.

The Court had two questions to decide—what did the license cover, and were the devices charged to infringe covered by the claims of the patents in suit? It answered both in accordance with the evidence. Although the Court having answered the first question, did not have to decide the second, nevertheless its decision as to infringement was not inconsistent with its decision as to what the license covered. Respondent's manufacturer had a *paid-up* license under which it could make joggers if it so desired. It does not follow that because it had this license it was obliged to, or did, make devices in accordance with the patents.

Point V.

Petitioner Claims that the Court of Appeals Erred in Failing to Follow the Findings of the District Court, Including a Finding of the Credibility of Petitioner's Witness, Without Showing Wherein Those Findings Were Clearly Erroneous as Required by Rule 52 (a) of the Federal Rules of Civil Procedure. The Court of Appeals Opinion Clearly and in Great Detail Discloses Wherein the District Court's General Findings Were Erroneous and the Non-Existence of Conflicting Testimony on Material Issues Made the Finding as to Credibility Immaterial.

The petitioner apparently realizes and concedes that the able and exhaustive decision of the Court of Appeals makes clear wherein that Court differed with the findings of the District Court, as petitioner makes no reference or explanation in its brief in support of the statement and claim that the Court of Appeals failed to show wherein the findings of the District Court were erroneous.

The finding relating to the credibility of petitioner's only witness is of no materiality in the final decision of this case. An examination of the statement of the material facts in this case discloses no substantial controversy of the parties with respect thereto. The facts upon which the Court of Appeals based its conclusion are not shown to have been in dispute. Petitioner makes the claim of error based upon alleged conflicting testimony, but does not set out in its petition for the writ any evidence which it claims was material and was the subject of contradictory testimony.

Characteristic of petitioner's claim that the Court of Appeals' opinion is based on assumptions of fact not supported by any evidence in the record is petitioner's objection under this point to the Court saying that petitioner "sold its business" (petitioner's petition for writ, p. 25). The record clearly supports the Court's opinion in this regard. By the terms of paragraph 2 of the license agreement dated August 10, 1931 (R. 192), the petitioner sold its drawings, tracings, prints, patterns, parts, castings, jiggs, tools and dies. The petitioner's president, when asked about the petitioner's business, testified that petitioner discontinued manufacturing joggers after the execution of the above mentioned license agreement (R. 60).

CONCLUSION.

Much of petitioner's argument is devoted to matters not pertinent to the questions presented in the petition. In view of the inhibition of Rule 38, we have refrained from discussing such matters.

The petition presents no ground for the exercise of this Court's jurisdiction. Petitioner's claims at the best are no more than an expression of dissatisfaction with the Court of Appeals opinion, which is fully sustained by the evidence in this case. Petitioner's objections were all fully and carefully considered by the Court of Appeals and rejected. We respectfully submit that there is no justification for the exercise by this Court of its power to grant a writ of certiorari.

Respectfully submitted,

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